

REMARKS

Claims 12, 13, and 21-24 are pending. Claims 26-32 have been cancelled as drawn to non-elected inventions. Cancellation of the claims does not affect inventorship.

Restriction Requirement

The Examiner requires Applicants to elect one of the following groups of inventions:

- I. Claims 12, 13, and 21-24, drawn to a first method for generating a protein library, classified in class 702, subclass 19;
- II. Claims 26-29, drawn to a second method for generating a protein library, classified in class 702, subclass 19;
- III. Claims 30-31, drawn to a third method for generating a protein library, classified in class 702, subclass 19; and
- IV. Claim 32, drawn to a fourth method for generating a protein library, classified in class 702, subclass 19.

Applicants elect Group I, claims 12, 13, and 21-24, drawn to a first method for generating a protein library, with traverse.

Applicants respectfully traverse the Examiner's Restriction Requirement for the following reasons. First, it is Applicants position that the search and examination of Groups I - IV can be made without serious burden. Second, Applicants submit that the Examiner has not given the particular reasons that he has relied upon for holding that the inventions as claimed are independent or distinct.

Under M.P.E.P. §803, "if the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions "(emphasis added). In addition, M.P.E.P. §808.02 states "where, however, the classification is the same and the field of

search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions."

Claims 12-24 and 26-32 are directed to methods of computationally generating a secondary library of protein variant using a forcefield calculation, thus the field of search should be the same. This is supported by the fact that the classification for inventions I, II, III, and IV is the same, *i.e.*, class 702, subclass 19. Finally, the Examiner has not provided any clear indication of separate future classification and field of search. Accordingly, Applicants respectfully submit that the search and examination of all of the claims belonging to groups I-IV can be made without serious burden.

In addition, the Examiner states that inventions I - IV are patently distinct methods which have different steps and different modes of operation. No further explanation for the holding is provided. Under M.P.E.P. 816, a mere statement of conclusion is inadequate. Applicants respectfully request specific reasons for this holding.

Accordingly, Applicants respectfully request that the Examiner examine claims 12-24 and 26-32 together on the merits.

The Examiner is invited to contact the undersigned at (415) 781-1989 if any issues may be resolved in that manner.

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Respectfully submitted,
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